UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JONG-HEE HAN

Appeal No. 2005-2228
Application No. 09/440,639[1]

HEARD: SEPTEMBER 15, 2005

Before KRASS, BLANKENSHIP and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-5, which are all of the claims pending in this application.

We reverse.

BACKGROUND

Appellant's invention is directed to an apparatus and method of controlling tape playback according to selected program ratings. A recorded program of a viewable grade is searched for

[1] Application for patent filed November 16, 1999, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of Korean Application No. 98-49772, filed November 19, 1998.

at high speed and played back when a currently-reproduced recorded program belongs to a nonviewable program grade (specification, page 2). An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. An apparatus for controlling playback according to program ratings, in a video/audio recording/playback controlling apparatus for reproducing signals from a recording medium in which a video signal having program rating data is recorded, the apparatus comprising:

a decoder for decoding the program rating data to generate decoded program rating data;

a controller for generating a first control signal for blocking a video/audio signal if a viewable program rating set by a user is lower than the rating of the decoded program rating data, and for generating a second control signal if a signal indicating a new program is detected; and

a tape speed controller for executing a high-speed search mode when the controller generates the first control signal, and for executing the general playback mode when the controller generates the second control signal.

The Examiner relies on the following references:

Choi	5,519,549	May 21, 1996
Yuen et al. (Yuen)	6,091,884	Jul. 18, 2000 (filed Dec. 30, 1996)
Abecassis	6,553,178	Apr. 22, 2003 (filed Sep. 8, 1994)

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Abecassis.

Claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Abecassis, Yuen and Choi.

Rather than reiterate the opposing arguments, reference is made to the briefs and answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

With respect to the 35 U.S.C. § 102 rejection of the claims, we note that a rejection for anticipation requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Appellant argues that Abecassis does not contain any teaching or suggestion relevant to a tape speed controller for executing a high-speed search mode, as recited in claim 1 (brief, page 4; reply brief, page 6). Additionally, Appellant points out

that the reference actually uses a random access feature that selects one version of the scene that is appropriate for the user according to the selected rating, but fails to teach or suggest a high-speed search when a controller generates a first control signal (reply brief, page 7; oral hearing).

The Examiner responds to Appellant's arguments by stating that Abecassis does disclose (col. 40, lines 26-36) the claimed tape speed controller as controlling the various speeds (fast forward, rewind, frame advance, skip) (answer, page 7). Reviewing the reference shows that the portions of Abecassis relied on by the Examiner disclose the types of control that the viewer may have over the replay after viewing the image and marking the beginning and end of a segment (col. 40, lines 9-24). However, absent any evidence or reasoning to show connection between a tape speed controller and the first and second control signals, we are unconvinced that the "fast forward" operation of Abecassis conclusively establishes the claimed relationship of the tape speed controller with respect to the control signals related to the set program rating and the detection of a new program.

The Examiner also points to the discussion of availability of the content-on-demand video to the user in Abecassis and how

it may be available in tape and CD formats (answer, page 7). Again, we do not agree with the Examiner that using the content rating in Abecassis, teaches or suggest the claimed tape speed controller and the two control signals. What a reference teaches is a question of fact. In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (citing In re Beattie, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992)). Here, the Examiner characterizes the editing out the objectionable segments that later may be viewed by the user and the transmission control by the user as the claimed tape speed controller responsive to the first and the second control signals. While the content of the program is discussed in the reference, as pointed out by Appellant (reply brief, page 7), the objectionable segments are edited out and replaced by similar scenes based on the selected segments (col. 29, line 19-28), not by the tape speed controller.

In view of the discussion above, since the claimed tape speed controller is absent in Abecassis, the reference cannot anticipate the claimed subject matter. Accordingly, as the Examiner has failed to meet the burden of providing a prima facie case of anticipation, the 35 U.S.C. § 102 rejection of claims 1, 2 and 4 over Abecassis cannot be sustained.

Turning now to the 35 U.S.C. § 103 rejection of claims 3 and 5, we note that the Examiner further relies on Yuen for teaching a video index search system (VISS) and on Choi for teaching that the index information is picked up by detecting the duty cycle variation (answer, page 6). However, since the Examiner has not pointed to any disclosure in these references that relates to a tape speed controller for high speed search and playback in response to the first and second control signals, respectively, the deficiencies of Abecassis as discussed above with respect to claims 1, 2 and 4 has not been overcome. Accordingly, we do not sustain the 35 U.S.C. § 103 rejection of claims 3 and 5 over Abecassis, Yuen and Choi.

CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1, 2 and 4 under 35 U.S.C. § 102 and rejecting claims 3 and 5 under 35 U.S.C. § 103 is reversed.

REVERSED

ERROL A. KRASS
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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